

REMARKS

Claims 1-6 and 8-24 are pending. By this Amendment, claim 7 is cancelled, claims 6, 9-11, 13-14, 16, 21-22 and 24 are rewritten to be in independent form, and claims 1 and 20 are amended to limit their scope to moving the active optical component with respect to the optical fiber.

A. The Office Action rejects claims 1-5, 7-8, 12 and 20 under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 6,450,702 to Komoriya et al. If applicable to the present claims, this rejection is respectfully traversed.

Anticipation under 35 U.S.C. §102 is a strict standard. "A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

1. Komoriya et al. does not disclose an optical module that includes "a positioning device for moving the active optical component with respect to the optical fiber" as specified in claim 1, and therefore contained in claims 2-5, 7-8 and 12 dependent on claim 1. Accordingly, withdrawal of the rejection of claims 1-5, 7-8 and 12 is earnestly solicited.

2. Furthermore, Komoriya et al. does not disclose a method of making an optical module that includes "assembling ... a positioning device capable of moving the active optical component with respect to the optical fiber" as specified in claim 20. Accordingly, withdrawal of the rejection of claim 20 is earnestly solicited.

B. The Office Action rejects claim 6 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,450,702 to Komoriya et al. If applicable to the present claims, this rejection is respectfully traversed.

Komoriya et al. does not disclose, teach or suggest an optical module that includes “a frame to which the optical fiber and the beam shaping optical component are affixed wherein the positioning device comprises a micro-machined movable stage affixed between the frame and the active optical component” as specified in claim 6. The Office Action even admits that Komoriya et al. does not disclose “the positioning device to comprise a micro-machined movable stage affixed between the frame 58 [of Komoriya et al.] and the active optical component 50 [of Komoriya et al.]”

Instead, the Office Action relies on In re Japikse, 86 USPQ 70 (CCPA 1950) for the proposition that it “has been held that rearranging parts of an invention involves only routine skill in the art.” For at least the following reasons, this proposition is traversed and the reliance on In re Japikse is deemed improper.

1. In re Japikse does not support this proposition.
2. In re Japikse was decided May 9, 1950, before enactment of the 1952 Patent Act, and in particular, before the enactment of 35 U.S.C. §103 under which claim 6 has been rejected.
3. In re Japikse was decided May 9, 1950, before the decision in Graham v. John Deere Co. in which the United States Supreme Court established the basic rules for analyzing the obviousness of a patent claim under 35 U.S.C. §103 and articulated three factual inquiries to be made in an obviousness determination. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). This analysis requires a factual inquiry into (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed subject matter, and (3) the level of skill of a person of ordinary skill in the art at the time the invention was made. The M.P.E.P. instructs that “examiners should apply the test for patentability under 35 U.S.C. §103 set forth in *Graham*.” See M.P.E.P. 2141 through 2143.
4. Even if, *arguendo*, the proposition “that rearranging parts of an invention involves only routine skill in the art” were to be established. The mere fact that parts could be rearranged does not establish motivation for rearranging the parts. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916

F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See M.P.E.P., section 2143.01, page 2100-98, Rev. 1, Feb. 2000, 7th Ed (emphasis in the original).

To establish a case of obviousness under current law, the Patent and Trademark Office must demonstrate by substantial evidence that the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated an ordinarily skilled person to modify the subject matter of a reference or combine the subject matters of the references to achieve the claimed subject matter. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). M.P.E.P. 2143.01 instructs that “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.” “[T]he central question is whether there is reason to combine references,” McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “[A] showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’,” Brown and Williamson Tobacco Corp. v. Phillip Morris Inc., 229 F.3d 1120, 1124-1125, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). The same applies to motivation to modify a reference. “[T]here must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant,” In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). “[T]eachings of references can be combined only if there is some suggestion or incentive to do so,” (emphasis in original), In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Motivation must be found with specificity. “[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed,” In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). “[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious,” In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The Patent Office can satisfy this burden of

showing the obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references,” In re Fitch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Furthermore, the determination of obviousness under 35 U.S.C. §103 is a legal conclusion that must be based on factual evidence. Burlington Indus., Inc. v. Quigg, 822 F.2d 1581, 1584, 3 USPQ2d 1436, 1439 (Fed. Cir. 1987). The results of the factual inquiries articulated in Graham v. John Deere Co. provide the factual basis upon which the legal conclusion of obviousness is to be based. This factual basis includes reasoned findings and substantial evidence supporting the reasoned findings. “[I]t is fundamental that rejections under 35 U.S.C. 103 must be based on evidence comprehended by the language of that section.” In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). For example, substantial evidence of prior art might be identified in a prior art patent. Assertions of Patent Office personnel do not constitute evidence.

The Office Action fails to establish a *prima facie* case for the obviousness of claim 6. Accordingly, withdrawal of the rejection of claim 6 is earnestly solicited.

C. The Office Action rejects claims 13-17, 19, 21 and 24 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,450,702 to Komoriya et al. in view of U.S. Patent Publication 20050111794 to Wang et al. If applicable to the present claims, this rejection is respectfully traversed.

Wang et al. is not prior art to the present application under 35 U.S.C. §103(c)(1) which states “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Both Wang et al. and the present application were, at the time of the invention, either “owned by the same person [Agilent] or subject to an obligation of assignment to the same person [Agilent].” Wang et al. does not qualify as prior art under any other of the subsections of section 102.

The Office Action admits that Komoriya et al. does not disclose “a positioning memory circuit operable to control the positioning device.” The Office Action then asserts “it would have been obvious at the time of the invention to modify the device as disclosed by Komoriya to include a positioning memory circuit, micro-heaters and solder.” This assertion is respectfully traversed. At least because Wang et al. is not prior art to the present application, the applied art provides no motivation or suggestion “to modify the device as disclosed by Komoriya to include a positioning memory circuit, micro-heaters and solder.” Accordingly, withdrawal of the rejection of claims 13-17, 19, 21 and 24 is earnestly solicited.

D. The Office Action rejects claims 18 and 22-23 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,450,702 to Komoriya et al. in view of U.S. Patent Publication 20050111794 to Wang et al. as applied to claim 16, and further in view of U.S. Patent No. 6,086,776 to Maynard. If applicable to the present claims, this rejection is respectfully traversed.

1. With respect to claim 18, Komoriya et al. in view of Maynard does not disclose, teach or suggest an optical module that includes “means for holding the positioning device in position that comprises an adhesive” “capable of activation by exposure to RF radiation” as specified in claim 18. As discussed above, Wang et al. is not prior art to the present application. Komoriya et al. in view of Maynard does not teach or suggest activation of an adhesive by exposure to RF radiation. The Office Action fails to set forth a *prima facie* case for the obviousness of claim 18 at least because there applied art does not disclose, teach or suggest activation of an adhesive by exposure to RF radiation. Accordingly, withdrawal of the rejection of claim 18 is earnestly solicited.

2. With respect to claims 22 and 23, Komoriya et al. in view of Maynard does not disclose, teach or suggest a method of making an optical module that includes “holding one of the pair of elements in position with respect to the other after aligning by activating an adhesive” as specified in claim 22, and therefore contained in claim 23. As discussed above, Wang et al. is not prior art to the present application. The Office Action fails to set forth a *prima facie* case for the obviousness of claims 22-23 at least because there applied art does not disclose, teach or suggest activation of an adhesive or activation by

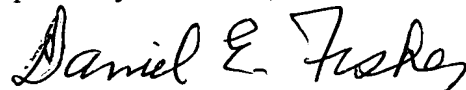
exposure to infrared or RF radiation. Accordingly, withdrawal of the rejection of claims 22 and 23 is earnestly solicited.

E. The Office Action objects to claims 9-11 as being dependent upon a rejected base claim, but indicates that claims 9-11 would be allowable if rewritten in independent form. Accordingly claims 9-11 have been rewritten in independent form.

In view of the above, favorable reconsideration is courteously requested. If there are any remaining issues that can be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,



Daniel E. Fisher, Reg. No. 34,162
Attorney/Agent for Applicants

MILLEN, WHITE, ZELANO &
BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: 10030542-1

Date: July 15, 2005

(DEF/rem) K:\Agilent\12\Reply to 6-7-05 OA.doc